

## **REMARKS**

The Applicant has carefully reviewed the Office Action mailed November 1, 2007 and offers the following remarks.

Claims 1-8, 10, 11, 15-25, 27, 28, 31, 32, and 34-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,631,188 B1 to *Sands* (hereinafter "*Sands*"). The Applicant has previously cancelled claims 18, 35, and 36, thereby rendering the rejection of these claims moot. The Applicant respectfully traverses the rejection as applied to the remaining claims.

Prior to addressing the rejection, the Applicant provides herewith a brief summary of the present invention. The present invention allows a user to establish a customized call waiting rule set to control whether call waiting alerts and associated caller identification information are provided to the user in association with an incoming call. Based on the configuration of the call waiting rule set, the call waiting alert may be blocked or provided to the user when an incoming call for the user is detected. According to the present invention, upon receipt of an indication of an incoming call, a service node will access the call waiting rule set for a called telephony terminal, and based on the call waiting rule set, screen the call by determining whether to instruct a telephony switch to proceed with providing the call waiting alert and associated caller ID information or to block the call waiting service. If the service node determines that the call waiting alert and associated caller ID information should be provided to a telephony terminal, the service node sends an IN Offer Call message (or alternatively a Continue message) to a telephony switch. The telephony switch will then take the necessary steps to provide the call waiting alert and caller ID information to the telephony terminal. The Applicant submits that none of the cited references disclose, or even suggest, providing an instruction to a telephony switch such that the telephony switch provides a call waiting alert to a user's telephone terminal.

Now turning to the rejection, according to Chapter 2131 of the M.P.E.P., in order to anticipate a claim under 35 U.S.C. § 102, "the reference must teach every element of the claim." The Applicant submits that *Sands* does not teach every element recited in claims 1-8, 10, 11, 15-17, 19-25, 27, 28, 32, and 34. More specifically, claim 1 recites a method for selectively controlling a provision of a call waiting alert comprising, among other features, "providing an instruction instructing the telephony switch whether to provide the call waiting alert to the user's telephone terminal." Claim 19 includes similar features. The Applicant submits that *Sands* does

not disclose providing an instruction to a telephony switch, which instructs the telephony switch to either provide or not provide a call waiting alert to a user's telephone terminal. In maintaining the rejection, the Patent Office asserts that *Sands* discloses this feature in Figure 5, at 138 or 148 and in col. 4, l. 6 through col. 5, l. 24.<sup>1</sup> The Applicant respectfully disagrees. With respect to the disclosure in Figure 5, at most, *Sands* discloses that in a step 138, a program "provides a call waiting alert indication to the called party via the called party's telephone terminal" and in a step 148 a program "proceeds to step 148 with the incoming call receiving a default or other call processing such as a busy signal, routing to voice mail, automatic call back, etc."<sup>2</sup> Thus, according to *Sands*, a program provides the functionality and instructions described in steps 138 and 148. However, nowhere does *Sands* disclose providing an instruction to a telephony switch instructing the telephony switch to either provide or not provide a call waiting alert to a telephone terminal.

Regarding the disclosure in col. 4, l. 6 through col. 5, l. 24, at most, *Sands* discloses providing a message to a local switch 64, where the message includes a call waiting tone.<sup>3</sup> According to *Sands*, the call waiting tone alerts a subscriber that an incoming call has been directed to call waiting.<sup>4</sup> However, nowhere does *Sands* disclose, or even suggest, providing instructions to a telephony switch, which instructs the telephony switch to either provide or not provide a call waiting alert to a telephone terminal. Instead, *Sands* is using the local switch 64 as a conduit to pass along a message to a telephone terminal. The local switch 64 is not being instructed to provide a call waiting alert. For this reason, claims 1 and 19 are patentable over *Sands* and the Applicant requests that the rejection be withdrawn. Likewise, claims 2-8, 10, 11, 16, 17, 20-25, 27, 28, 31, and 32, which ultimately depend from claim 1 or 19, are patentable for at least the same reasons along with the novel features recited therein.

Claim 15, which depends from claim 1, recites that "the call waiting rule set is customized such that providing the call waiting alert is based at least in part on a relative priority or urgency associated with the incoming call." Claim 34, which depends from claim 19, includes similar features. Initially, the Applicant wishes to point out that the Patent Office has not specified, at all, how claims 15 and 34 are anticipated by *Sands*. This problem notwithstanding,

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<sup>1</sup> See Office Action mailed November 1, 2007, page 2.

<sup>2</sup> See *Sands*, col. 6, lines 15-17 and 29-32.

<sup>3</sup> See *Sands*, col. 4, l. 67 – col. 5, l. 7.

<sup>4</sup> See *Sands*, col. 5, ll. 7-9.

the Applicant submits that *Sands* does not disclose a call waiting rule set, which is customized such that providing the call waiting alert is based at least in part on a relative priority or urgency associated with the incoming call. In maintaining the rejection, the Patent Office asserts that *Sands* discloses this feature at col. 6, lines 1-13.<sup>5</sup> The Applicant respectfully disagrees. While the cited portion of *Sands* does disclose identifying an incoming calling ID and looking up the ID, the cited portion does not disclose that a call waiting rule set is customized such that providing the call waiting alert is based at least in part on a relative priority or urgency associated with the incoming call. In fact, the Applicant has reviewed the remaining portions of the reference and submits that nowhere does the reference disclose these features. Accordingly, in addition to the reasons noted above with reference to claims 1 and 19, claims 15 and 34 are patentable over the cited reference and the Applicant requests that the rejection be withdrawn.

Claims 13, 15, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sands* in view of U.S. Patent No. 6,519,335 B1 to *Bushnell* (hereinafter "*Bushnell*"). The Applicant respectfully traverses the rejection.

According to Chapter 2143.03 of the M.P.E.P., in order to "establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." The Applicant submits that neither *Sands* nor *Bushnell*, either alone or in combination, discloses or suggests all the features recited in claims 13, 15, and 30. As described above, claims 1 and 19, the base claims from which claims 13, 15, and 30 respectively depend, are patentable over *Sands*. In addition, *Bushnell* does not overcome the previously noted problems of *Sands*. As such, claims 13, 15, and 30 are patentable over the cited references and the Applicant requests that the rejection be withdrawn.

Claims 9, 12-14, 26, 29, and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sands* in view of *Bushnell* and further in view of U.S. Patent Application Publication No. 2002/0141559 A1 to *Gurgun* to (hereinafter "*Gurgun*"). The Applicant respectfully traverses the rejection. As detailed above, claims 1 and 19, the base claims from which claims 9, 12-14, 26, 29, and 33 respectively depend, are patentable over *Sands*. Moreover, *Gurgun* does not overcome the previously noted problems of *Sands*. Thus, claims 9, 12-14, 26, 29, and 33 are patentable over the cited references and the Applicant requests that the rejection be withdrawn.

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<sup>5</sup> See Office Action mailed November 1, 2007, page 5.

The present application is now in a condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact the Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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